

Applicant(s) : Hartmut Sauer
Serial No. : 10/553,242
Filed : October 14, 2005
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Attorney Docket No.: 68001-007US1

AMENDMENTS TO THE DRAWINGS

The attached two new sheets of drawings includes original Figures 1-4 presented in WO 2004/091906 A2.

REMARKS

This document is submitted in reply to the Office Action dated August 1, 2008 (“Office Action”).

Applicant has amended claims 1-3 and 6-23 to more particularly point out the subject matter that they deem as their invention. Further, Applicant has added three new claims, i.e., claims 25-27. Minor deficiencies in claims 1, 3, 8, 9, 12, 14, 15, 18-20, and 23 have been corrected. Applicant has also corrected minor deficiencies in the Specification. Finally, Applicant has cancelled claims 4, 5, and 24. No new matter has been introduced by the amendments.

Upon entry of the amendments, claims 1-3, 6-23, 25-27 will be pending and under examination. Applicant respectfully requests that the Examiner reconsider this application in view of the following remarks.

Claim Objections

The Examiner objects to claims 1, 8, 9, 12-14, and 19-24 for informality and requests appropriate corrections. See the Office Action, page 4, lines 9-19. Applicant has corrected claims 1, 8, 9, 12-14, and 19-23 and cancelled claim 24.

Specification Objections

The Examiner objects to the Abstract for informality and requests that it be corrected. Applicant has complied with the Examiner’s request.

The Examiner also sets forth guidelines as to how to lay out a specification and suggests that Applicant follows them. See the Office Action, page 2, lines 4-32. Applicants have amended the Specification accordingly. In particular, section headings have been added.

The Examiner also points out that the four figures referred to in the Specification and a brief description of these figures is missing. Applicant has rectified these deficiencies.

Rejection under 35 U.S.C. § 101

The Examiner rejects claims 1-24 “because the claimed recitation of a use **without setting forth any steps** involved in the process, results in an improper definition of a process.” See the Office Action, page 7, lines 11-14; emphasis added. In other words, it is the Examiner’s position that as the ‘use’ covered by claims 1-24 does not define a process, the claimed subject matter is not patentable.

Applicant has amended claims 1-24 so that they now **set forth steps** involved in the claimed process and request that the Examiner withdraw the rejection and reconsider them as amended.

Rejection under 35 U.S.C. § 112, 2nd paragraph

The Examiner rejects claims 1-24 as indefinite. In particular it is the Examiner’s position that it is unclear what method/process Applicant is intending to encompass as the claims merely recite a use without any active, positive steps delimiting how this use is practiced. See the Office Action, page 3, lines 7-10. Claims 4, 5, and 24 have been cancelled. The remaining claims, i.e. claims 1-3 and 6-23, have been amended to include steps that actively and positively delimit how the claimed method is practiced.

The Examiner also rejects claims 8, 9, and 15 as indefinite on a second ground. According to the Examiner, the meaning of the phrase “in particular” is unclear. See the Office Action, page 8, lines 6-13. Applicant has removed the phrase and its related context from claims 8, 9, and 15.¹

The Examiner further rejects claim 18 as indefinite on the ground that the phrase “the metal dispersion layer” does not have an antecedent basis. See the Office Action, page 8, lines 14-15. Applicant has changed the dependency of claim 18 from claim 1 to claim 16, which provides an antecedent basis for the phrase at issue.

¹ This amendment has necessitated change of the dependency of claim 9 and addition of new claims 25 and 26.

Rejection under 35 U.S.C. § 102/103

The Examiner rejects claims 1-24 as anticipated or, alternatively, rendered obvious by Jansson, U.S. Patent No. 4, 231, 982 ("Jansson"). See the Office Action, page 9, lines 8-10.

Independent claim 1 will be discussed first. This claim as amended covers a method for producing an article having a surface formed of a composite material. This method includes the following two steps: (1) microstructuring a surface of a non-metallic substrate and (2) depositing a metallic layer onto the surface of the non-metallic substrate without applying an external current. The surface of the non-metallic substrate generated by step (1) is **rough**. See the Specification, figure 2-4.

According to the Examiner, Jansson describes a method for the production of a moulding/extruding tool, in which a non-metallic substrate is coated, in the absence of an electric current, with a metallic layer. See the Office Action, page 9, lines 11-21.

Applicants would like to point out that Jansson does **not** teach or suggest that the surface of the non-metallic substrate is **rough**. Indeed, Jansson describes that the tool obtained is an exact copy of the working model, which is made of a non-metallic substrate having a **smooth** surface. See column 2, lines 35-42, lines 55-57, and column 3, lines 10-11. In other words, the metallic layer is deposited onto a **smooth** non-metallic substrate, not a **rough** non-metallic substrate as required by amended claim 1.

For the reasons and facts set forth above, claim 1 is not anticipated or rendered obvious by Jansson. Nor are claims 2-3 and 6-23, all of which depend, directly or indirectly from claim 1.

Double Patenting Rejections

The Examiner provisionally rejects claims 1-24 under the judicially created doctrine of obviousness-type double patenting as being obvious over claims 1-24 of U.S. Application No. 10/553,145. The Examiner also provisionally rejects claims 1-20 and 24

for obviousness-type double patenting in view of claims 1-21 of U.S. Application No. 10/553,147. Claims 4, 5, and 24 have been cancelled.

Applicants would like to point out that “[i]f ‘provisional’ nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should then withdraw that rejection and permit the earlier-filed application to issue as a patent.” See M.P.E.P. § 804. Both applications No.10/553,145 and 10/553,147 were filed after the filing date of this application. In view of the amendments and remarks presented herein, Applicant submits that all other rejections have been overcome. Accordingly, it is requested that the two provisional double patenting rejections be withdrawn.

New claims

Three new claims, i.e., claims 25-27, have been added to cover particular embodiments of this invention.

For the same reasons set forth above, these new claims are patentable over Jansson.

Applicants respectfully request that upon allowance of claim 1, these new claims also be allowed.

CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment.

In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed.

Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the

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amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

The Petition for Extension of Time fee in the amount of \$ 130 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 68001-007US1.

Respectfully submitted,

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